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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
SIDDIQI, MOHAMMAD A	
ART UNIT	**PAPER NUMBER**
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/780,962	REED, ERIK JAMES	
	Examiner	Art Unit	
	Mohammad A. Siddiqi	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02/16/2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4-16,18-29,32-36 and 55-58* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4-16,18-29,32-36 and 55-58* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *02/16/2007*, 04/10/07
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1, 4-16, 18-29, 32-36 and 55-58 are presented for examination. Claims *2,3, 17, 30-31 and* 37-54 have been cancelled.

2. The information disclosure statement (IDS) submitted on 04/10/2007 being considered by the examiner.

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/16/2007 has been entered.

Specification

4. Claims 4-16, 18-22, 36, and 55-58 objected to because of the following informalities: The focus of the examination inquiry is whether everything within the scope of the claim is enabled. Accordingly, the first

analytical step requires that the examiner determine exactly what subject matter is encompassed by the claims. >See, e.g., AK Steel Corp. v. Sollac, 344 F.3d 1234, 1244, 68 USPQ2d 1280, 1287 (Fed. Cir. 2003). A claim in a dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers and requires the dependent claim to further limit the subject matter claimed. See MPEP. Appropriate correction is required.

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: specification does not properly disclose subject matter such as: Digitized content master and master songprint identifier, as claimed in claims 1, 23, 25 and 27.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 4-16, 18-28, 36, and 55-58 are directed to an apparatus. Specifically, claim 1 is directed to a network server. However, it has been held that a single claim which purports to be both a product or machine and a process is ambiguous and is properly rejected under 35 USC 112, second paragraph, for failing to particularly point out and distinctly claim the invention (Ex Parte Lyell, 17 USPQ2d 1548 (B.P.A.I. 1990)). Therefore, as Applicant's *claims* recite both structure (i.e. a verification database) and method steps (e.g. receive" steps, "determine" steps) *Claim 1* is rejected under 112 second paragraph.

8. It has been held that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; In re Swineheart, 169 USPQ 226; In re Schreiber, 44 USPQ2d 1429 (Fed. Cir. 1997)). Therefore, Applicant's claims that are directed to "receive" steps, "determine" steps, for example, do not distinguish Applicant's claims from the prior art. Similarly, the type of data that is stored in the database (e.g. "information corresponding to...") also will not differentiate the claimed database from the database PA (In re Gulack, 217 USPQ 401 (Fed. Cir. 1983), In re Ngai, 70 USPQ2d (Fed. Cir. 2004), In re Lowry, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01.)

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1, 4-16, 18-29, 32-36 and 55-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over anticipated by Hurtado et al. (6,611,812) (hereinafter Hurtado) in view of Carpentier et al. (6,807,632) (hereinafter Carpentier).

11. As per claim 1, Hurtado discloses in a system comprising a communications network connecting a plurality of network servers and a plurality of user devices (109, fig 1D), a network server comprising:

a verification database comprising information corresponding to each of a plurality of digitized content masters (126, 160, fig 1, col 26, lines 45-65, and col 31, lines 55-64), for each digitized content master the verification database comprising:

table of contents information corresponding to the digitized content master (metadata provides information about the content, quality, condition,

and other characteristics of data, here metadata provides information about the music CD .g., artist, producer, album cover, track length, 160, fig 1, col 12, lines 17-25);

program code operative to cause the server to (Digital Content Electronic Distribution System, 100, fig 1A, col 11, lines 9-64):

receive table of contents information from a user device of the plurality of user devices (A Secure Container (SC), 109, fig 1D, col 26, line 45 – col 28, line 39);

determine whether to provide authorization information to the user device using said verification database, the received table of contents information and the received table of contents information and the received at least one of songprint identifiers (col 10, lines 31-64; col 26, line 45 – col 28, line 39).

However, Hurtado does not explicitly disclose at least one songprint identifier derived from the digitized content master and receive at least one songprint identifiers derived from digitized content at the user device. Carpentier discloses at least one songprint identifier derived from the digitized content master and receive at least one songprint identifiers derived from digitized content at the user device (e-CLIP is a reproducible, reliably unique identifier for collection of digital information, 302-310, fig 3, col 4, line 25-67, col 5, lines 19-31). Therefore, it would have been obvious

to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Carpentier and Hurtado. The motivation (as it is evidenced in col 15-16, 27-28, such as finger printing and also the audio file created for the sample **clip is** passed as a metadata file to be included in the Metadata SC(s)) would have been to secure delivery and rights management of digital assets over global communication network.

12. As per claim 4, the claim is rejected for the same reasons as claim 1, above. In addition, Hurtado discloses wherein the table of content information comprises at least one length of digital content (fig 16, col 61, lines 25-29).

13. As per claim 5, the claim is rejected for the same reasons as claim 1, above. In addition, Hurtado discloses to request at least one of a plurality of regions of digitized content from the user device (609, fig 6 and 16, col 95-96).

14. As per claim 6, the claim is rejected for the same reasons as claim 1, above. In addition, Hurtado discloses to request one region of digitized content from the user device (109, fig 1D, col 95-96).

15. As per claim 7, the claim is rejected for the same reasons as claim 1, above. In addition, Carpentier discloses the request for one or more regions of digitized content is generated as a function of a pseudo-random sequence (col 4, lines 26-67).

16. As per claim 8, the claim is rejected for the same reasons as claim 1, above. In addition, Carpentier discloses the pseudo-random sequence is a function of a network address of the user device (609, fig 6, col 4, lines 26-67).

17. As per claim 9, the claim is rejected for the same reasons as claim 1, above. In addition, Carpentier discloses wherein the pseudo-random sequence is a function of a time of day (fig 2, col 4, lines 26-67).

18. As per claim 10, the claim is rejected for the same reasons as claim 1, above. In addition, Carpentier discloses wherein the pseudo-random sequence is a function of both a network address of the user device and a time of day (609, fig 6, col 4, lines 26-67).

19. As per claim 11, the claim is rejected for the same reasons as claim 1, above. In addition, Hurtado discloses wherein the request for regions of

digitized content is further comprised of a request for at least one of a plurality of decoy regions of digitized content the user device (SC processor creates a request order on the end user device, please see the discussion of the Digital Secure Container structure which contains the key to verify, fig 3, col 88, lines 29-67).

20. As per claim 12, the claim is rejected for the same reasons as claim 1, above. In addition, Carpentier discloses wherein the request for an at least one of a plurality of decoy regions of digitized content is a function of a pseudo-random sequence (see discussion, col 4, line 26- col 5 line 19).

21. As per claim 13, the claim is rejected for the same reasons as claim 1, above. In addition, Carpentier discloses wherein the pseudo-random sequence is a function of a network address of the user device (col 4, line 26- col 5 line 19).

22. As per claim 14, the claim is rejected for the same reasons as claim 1, above. In addition, Carpentier discloses wherein the pseudo-random sequence is comprising a function of a time of day (see discussion, col 4, line 26- col 5 line 19).

23. As per claim 15, the claim is rejected for the same reasons as claim 1, above. In addition, Carpentier discloses wherein the pseudo-random sequence is comprising a function of both a network address of the user device and the time of day (see discussion, col 4, line 26- col 5 line 19).

24. As per claim 16, the claim is rejected for the same reasons as claim 1, above. In addition, Carpentier discloses wherein the request for one or more than regions of digitized content is further comprised of only one non-decoy region of digitized content from the user device (see discussion, col 4, line 26- col 5 line 19).

25. As per claim 18, the claim is rejected for the same reasons as claim 1, above. In addition, Carpentier discloses wherein the verification database is further comprised of only one songprint identifier derived from the digitized content master (fig 3, col 7, line 15 to col 8, line 25).

26. As per claims 19 and 32, the claim is rejected for the same reasons as claim 1, above. In addition, Hurtado discloses further programmed to verify whether the received table of content information correlates with the table of content information corresponding to any of the plurality of digitized content

masters (fig 3, col 7, line 15 to col 8, line 25).

27. As per claims 20, 24, 28 and 33, claims are rejected for the same reasons as claim 1, above. In addition, Hurtado discloses to verify whether the received table of content information correlates perfectly with the table of content information corresponding to any of the plurality of digitized content masters (col 31, lines 55-64).

28. As per claims 21, the claim is rejected for the same reasons as claim 1, above. In addition, Carpentier discloses programmed to verify whether the received songprint identifiers correlates with the songprint identifier derived from any of the plurality of the digitized content masters (e-clip, fig 3, col 7, line 15 to col 8, line 25).

29. As per claims 22, 26, 34, and 35, claims are rejected for the same reasons as claim 1, above. In addition, Carpentier discloses further programmed to verify whether the received songprint identifier correlates perfectly with any master songprint identifier (derived from any of the plurality of the digitized content masters (fig 3, col 7, line 15 to col 8, line 25).

30. As per Claim 23, 25, 27 and 29 are rejected based on the same reasoning as claim 1, in addition to Hurtado discloses as a function of whether or not the received selections of table of contents information correlate with any of the table of contents information of the verification database (col 31, lines 55-64 and col 12, lines 17-25),

request at least one of a plurality of regions of the digitized content from the user device (SC processor creates a request order on the end user device, please see the discussion of the Digital Secure Container structure, fig 3, col 88, lines 29-67, col 88, lines 33-51).

31. As per claim 36, the claim is rejected for the same reasons as claim 1, above. In addition, Carpentier discloses read table of contents data from the medium (see discussion, col 4, line 26- col 5 line 19);

compute a cryptographic hash value of the concatenation of the lengths of each track on the medium (see discussion, col 4, line 26- col 5 line 19); and

truncate the cryptographic hash value (see discussion, col 4, line 26- col 5 line 19).

32. As per claim 55, the claim is rejected for the same reasons as claim 1, above. In addition, Carpentier discloses each received songprint identifier is

derived from a digitized content copy (see discussion, col 4, line 26- col 5 line 19).

33. As per claim 56, the claim is rejected for the same reasons as claim 1, above. In addition, Carpentier discloses the received table of contents information and at least one songprint identifier corresponding to the digitized content copy, and wherein the program code further comprises code operative to cause the server to use the received table of contents information and at least one songprint identifier to identify a correlation between a digitized content master having corresponding information stored in the verification database and the digitized content copy (Fig 3, col 4, line 26- col 5 line 19, and col 7, line 15 to col 8, line 25).

34. As per claim 57, the claim is rejected for the same reasons as claim 1, above. In addition, Carpentier discloses the server is further programmed to verify the digitized content copy using information stored in the verification database corresponding to the correlated digitized content master (Fig 3, col 4, line 26- col 5 line 19, and col 7, line 15 to col 8, line 25).

35. As per claim 58, the claim is rejected for the same reasons as claim 1, above. In addition, Carpentier discloses the server is further programmed to

request at least one content portion of the digitized content copy using the identified correlation between one of the digitized content masters and the digitized content copy (see discussion, col 4, line 26- col 5 line 19, col 7, lines15-26).

Response to Arguments

36. Applicant's arguments filed 02/16/2007 have been fully considered but they are not persuasive, therefore rejections to claims 1, 4-16, 18-29, 32-36 and 55-58 is maintained.

37. Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

38. In general, Applicant's arguments reflect a difference of opinion over the teachings of the prior art and how these teachings would be evaluated in light of the knowledge generally available to those in the appropriate art and the level of ordinary skill in the art. Moreover, Applicant's take an overly narrow view of the claim language.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Hurtado discloses a verification database comprising information corresponding to each of a plurality of digitized content masters (126, 160, fig 1, col 26, lines 45-65, and col 31, lines 55-64), for each digitized content master the verification database comprising: table of contents information corresponding to the digitized content master (metadata provides information about the content, quality, condition, and other characteristics of data, here metadata provides information about the music CD .g., artist, producer, album cover, track length, 160, fig 1, col 12, lines 17-25); program code operative to cause the

server to (Digital Content Electronic Distribution System, 100, fig 1A, col 11, lines 9-64): receive table of contents information from a user device of the plurality of user devices (A Secure Container (SC), 109, fig 1D, col 26, line 45 – col 28, line 39); determine whether to provide authorization information to the user device using said verification database, the received table of contents information and the received table of contents information and the received at least one of songprint identifiers (col 10, lines 31-64; col 26, line 45 – col 28, line 39).

Hurtado further discloses in columns 16-17 "In the Secure Digital Content Electronic Distribution System 100, since **SC(s)** contain several data parts, a digest is calculated for each part and a summary digest is calculated for the concatenated part digests. The summary digest is encrypted using the private key of the issuer of the SC(s). The encrypted summary digest is the issuer's digital signature for the SC(s). The part digests and the digital signature are included in the body of the SC(s). The recipients of SC(s) can verify the integrity of the SC(s) and its parts by means of the received digital signature and part digests. Carpentier discloses at least one songprint identifier derived from the digitized content master and receive at least one songprint identifiers derived from digitized content at the user device (e-CLIP is a reproducible, reliably unique identifier for collection of digital information, 302-310, fig 3, col 4, line 25-67, col 5, lines 19-31). Therefore,

it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Carpentier and Hurtado. The motivation (as it is evidenced in col 15-16, 27-28, such as finger printing and also the audio file created for the sample **clip is** passed as a metadata file to be included in the Metadata SC(s)) would have been to secure delivery and rights management of digital assets over global communication network.

39. Applicant's arguments with respect to amended claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

40. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad A. Siddiqi whose telephone number is (571) 272-3976. The examiner can normally be reached on Monday -Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MAS

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SUPERVISORY PATENT EXAMINER